PATENT APPLICATION
Attorney Docket No. 3561-068

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Elijahu SHAPIRA		Confirmation No. 1290
Serial No.:	09/707,541	Examiner: Timothy M. Harbeck
Filed:	November 6, 2000	Group Art Unit: 3628
For:	METHOD AND APPARATUS FOR REAL-TIME REPORTING OF ELECTRONIC COMMERCE ACTIVITY	
Date:	February 15, 2007	

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Commissioner for Patents
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APPELLANT'S BRIEF
UNDER 37 C.F.R. § 41.37

Appeal is taken from the Examiner's Office Action mailed September 26, 2006 rejecting claims 1-9 in the instant application.

This Appeal Brief is in furtherance of the Reinstatement of Appeal filed in this case on December 20, 2006.

Pursuant to M.P.E.P. § 1204.01, Reinstatement of Appeal, no additional fees are required as Appellant has previously paid appeal fees set forth in 37 C.F.R. § 41.20, and which are eligible to be applied to the new appeal as no final Board decision has been made on the prior appeal.

This Brief contains these items under the following headings, and in the order set forth below.

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST
37 CFR § 41.37(c)(1)(i)

The real party in interest in this appeal is WebTrends Inc., the assignee of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES
37 CFR § 41.37(c)(1)(ii)

There are no other appeals or interferences known to Appellant, the Appellant's representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS
37 CFR § 41.37(c)(1)(iii)

1. Claims presented: 1-9
2. Claims rejected: 1-9
3. Claims allowed or confirmed: NONE
4. Claims withdrawn: NONE
5. Claims objected to: NONE
6. Claims cancelled: NONE

All the rejected claims, Claims 1-9, are being appealed. The appealed claims are eligible for appeal, having been finally rejected on January 19, 2006. Upon the filing of Appellant's Appeal Brief filed on June 19, 2006, prosecution was reopened, however claims 1-9 were further rejected on September 26, 2006.

IV. STATUS OF AMENDMENTS
37 CFR § 41.37(c)(1)(iv)

Subsequent to the last Office Action mailed on September 26, 2006, which contained a further rejection of the appealed claims, no further amendments have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER
37 CFR § 41.37(c)(1)(v)

There is one independent claim, 1, involved in this appeal.

The claims in the instant application are directed to a method for tracking and reporting electronic commerce activity over a web site. Briefly, visitors to commercial web sites often order products online. The particular web page visited includes code responsible for displaying the web page on the visitor's computer. The web page also includes "data mining code" implemented according to the invention. The data mining code is downloaded to the visitor computer along with the web page and operated on the visitor computer to obtain technical and commercial data directly from the visitor computer. That is, a visitor to a commercial web site would enter information into data fields of a web page, such as the type and number of products to be ordered, and the data mining code would be operated on the visitor computer to extract this entered information and transmit it to a second (*e.g.*, a third-party tracking) server. In this way, an employee for a commercial web site could browse to the commerce tracking website and review a report of commercial data compiled from data received from all visitor computers ordering products from the commercial web site tracked. Prior to this technique, commercial web sites would need their own commerce tracking servers where information is extracted directly from the web servers at the commercial site instead of being forked from the visitor computer directly and stored off-site.

An example of a transmission from the visitor computer created by the data mining code embedded within the commerce web page would be as follows:

> The variable image source constructed by the inserted commercial activity tracking script can be shown as, for instance, www.webtrendslive.com/button3.asp?usd-lawn_chair#1-1445-002-2499, corresponding to price in U.S. dollars, product name: "lawn chair #1", product category #1445, 2 units sold at a per unit price of $24.99. Decoder software operable within server 22 reverse engineers the order to extract commercial activity data based on the source of the image requests. (Application, page 5, lines 16-21)

A. Independent Claim 1

Claim Language	Support in Specification/Figures
A method for tracking and reporting electronic commerce activity over a web site comprising:	
storing a web page on a first server coupled to a wide area network, said web page including data fields reflecting commerce transaction activity and data mining code;	First (*e.g.*, commercial) server: FIG. 1 (12) Web page shown at FIG. 2. Data fields shown in FIG. 2. Data mining code shown in Appendices I/II
uploading the web page including the data fields and data mining code to a visitor computer responsive to a request over the wide area network from the visitor computer;	Application page 3, lines 2-4. Visitor computer: FIG. 1 (14)
accepting commerce information within the data fields of the web page at the visitor computer to form a completed web page;	Data fields shown in FIG. 2 include quantity field and product type. Application, page 5, lines 10-15.
operating the data mining code on the visitor computer to obtain technical and commercial data; and	Application, page 4, lines 4-16 and page 5, lines 16-21.
receiving the technical and commercial data at a second server.	Second server: FIG. 1 (20)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL 37 CFR § 41.37(c)(1)(vi)

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,128,624 (Papierniak, et al.) in view of *WebSide Story Introduces StatMarket eData Mining – the Most Powerful Tool Available for Gathering E-Commerce Knowledge*, Business Wire, New York, September 21, 1999 ("Business Wire article").

VII. ARGUMENT
37 CFR § 41.37(c)(1)(vii)

The general issue is whether claims 1-9 are unpatentable in view of the prior art references under 35 U.S.C. § 103(a). Briefly, the specific issues can be stated as follows:

A. Papierniak teaches just the type of prior art system (and accompanying drawbacks) that the present invention is intended to overcome.

   a. Because Papierniak mines tracking and sensing data at the Internet Service Provider (ISP) rather than at the visitor computer itself, Papierniak does not teach the step of uploading a web page with data fields and mining code to the visitor computer as there would be no need to include such code within the web page.

   b. Because Papierniak mines tracking and sensing data at the Internet Service Provider (ISP) rather than at the visitor computer itself, Papierniak does not teach the step of operating data mining code *on the visitor computer* to obtain technical and commercial data.

B. The newly cited Business Wire article announcing an e-commerce Internet tool marketed by WebSideStory gives no further information than is already included in Appellant's Background of the Invention section.

   a. There is no disclosure within the Business Wire article that the WebSideStory service tracks "commerce transaction activity" (e.g. purchases made from the web sites); instead the prior art process only tracks visitor traffic to the web site.

   b. Nothing within the article implies that a web site has data fields, that such data fields are filled in, and that the amount with which those data fields are filled in is reported to a second (e.g. third party) server.

C. Combining Papierniak and the Business Wire article would not teach all limitations of the claims and accordingly a prima facie case for rejection of the claims under §103(a) fails as a matter of law. Furthermore, there is no suggestion within the cited art to implement client-side commercial data mining by embedding script within web pages while also using server-side data mining systems such as Papierniak since combining these systems would be redundant.

These issues will be divided into respective subsections and each ground for rejection will be addressed separately according to prior art (*e.g.*, Papierniak and the Business Wire article).

A. The Papierniak Reference

The Papierniak patent addresses the problem of integrating data from a variety of sources (*e.g.*, Internet Service Providers such as AOL and Commerce Service Providers such as sharperimage.com) into a predetermined format for supporting collection of the Internet and/or electronic commerce data. (Papierniak, Col. 5, lines 39-44)

What the Papierniak patent does not appear to teach is pulling commerce data from the visiting computer – *e.g.,* the computer of the consumer him/herself. That is, the Papierniak system places the burden of tracking and sensing of customers on the ISPs used by the customers and the servers on which the commercial sites and commercial transaction systems operate.

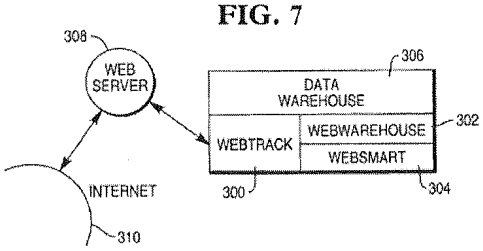
There is no step in Papierniak of uploading a web page with data fields and mining code to the visitor computer and operating that data mining code on the visitor computer to obtain commercial and technical data. Instead, any commercial and technical data would be obtained from the ISP or CSP computers themselves and would be integrated within a separate database:

> "From the user perspective, there are, at least, two types of users: visitors and the ISP's/CSP's customers.... The profile data related to the ISP/CSP customers should include, for example: company name... billing contact [etc.].... The visitor profile data, in addition to the domain name and IP addresses, depends on how much information the visited applications can entice the visitors to provide and what the visitors are willing to share with the ISP/CSP.... The capture of Web access activity requires interfaces to other network accessible systems such as modem pools and routers." (Papierniak Col. 15, line 52 to Col. 16, line 23 *emphasis added*)

It is clear then that tracked data is produced and maintained at the server side, rather than the client side. When visitors not part of the ISP/CSP are tracked, the system depends upon an election by the visitor to manually enter the information based on requests made by the system. This manual entry of data occurs, for example, when a visitor would complete an online demographic survey. Another example would be the "interview questionnaire" format noted in Papierniak beginning Col. 20, line 38 with reference to FIG. 14.

The Papierniak system, using server-provided and maintained data, operates in stark contrast with that of the present invention which gleans data from automated processes taking part at the client (visitor) machine using the data mining code to derive commercial information from transactions occurring over a web page. Not only does server-side data collection such as taught in Papierniak (and shown in FIG. 7 to the left) teach away from the present invention, but the present invention was developed to address the drawbacks of server-side data collection systems. These Papierniak systems require high levels of data sharing and cooperation between ISPs, CSPs, and data reporting agencies. As in the past, presently ISPs and CSPs do not lightly share such information with these data reporting agencies. The present invention does away with the need for such cooperation by embedding ecommerce data mining code within the served web pages themselves and operating such code on the receiving computer to trigger ecommerce transaction reporting to a second server.

FIG. 7



The Examiner states that Papierniak teaches the step of storing a web page on a first server (308 [FIG. 7]) where the web page includes data field reflecting commerce transaction activity and data mining code (OA dated Sept. 26, 2006, page 3). The Examiner specifically identifies item 306 in FIG. 7 as teaching such an element.

Appellant traverses. Papierniak clearly does not teach that a web page includes data fields and data mining code.

First, Papierniak discloses only generally that element 306 in FIG. 7 is a "general data warehouse" for storage of non-web specific data. Element 306 is not a web page. Additionally, nothing in Papierniak element 306 identifies it as having data fields and/or data mining code. Element 306 is simply a server-side database.

Second, the Examiner has given conflicting information. On one hand, the Examiner states that Papierniak discloses the step of "storing a web page" on a first server where said web page "includes data fields reflecting commerce transaction activity and data mining code." On the other hand, the Examiner states that Papierniak does not disclose the step of "operating the data mining code" on the visitor computer to obtain technical and commercial data. It is inconceivable to believe that a web page would include data fields and data mining code on one hand, yet such fields and code would not be operated on the visitor computer. Since including

the code within a web page takes up valuable memory space and bandwidth, and since the only purpose of including such code would be to operate the code on the receiving computer (e.g. visitor computer), then the only possible explanation of why an operation step does not take place is that Papierniak does not in fact include such elements within its web page.

In summary, therefore, Papierniak does not teach, *inter alia*, several of the steps in claim 1 involving the operation of data mining on the visitor computer where such code is embedded within the web page. There is no suggestion In Papierniak of client-side tracking using embedded data mining code for commercial information as claimed in the present invention. Accordingly, it would be impossible to see how the teachings of Papierniak could be incorporated into a client-side tracking scheme since there is no suggestion of such a combination within the reference.

B. The Business Wire Article Reference

The Examiner has apparently confused the concept of "eCommerce Knowledge" as described in the Business Wire article with "commerce *transaction* activity" as noted within the claims. There is no order information tracked within the WebSideStory system described in the Business Wire article; only page views and the like.

The WebSideStory tracking methods described in the newly cited Business Wire article adds nothing new to what has been before the Examiner. The methods described are essentially identical to those described in Appellant's Background of the Invention section. Pertinent portions of this section are included below:

> "Analyzing activity on a worldwide web server from a different location on a global computer network ("Internet") is also known in the art. To do so, a provider of remote web-site activity analysis ("service provider") generates JavaScript code that is distributed to each subscriber to the service. The subscriber copies the code into each web-site page that is to be monitored. When a visitor to the subscriber's web site loads one of the web-site pages into his or her computer, the JavaScript code collects information, including time of day, visitor domain, page visited, etc. The code then calls a server operated by the service provider—also located on the Internet—and transmits the collected information thereto as a URL parameter value. Information is also transmitted in a known manner via a cookie. Each subscriber has a password to access a page on the service provider's server. This page includes a set of tables that summarize, in real time, activity on the customer's web site." (Application, page 1, lines 19-29)

Compare the above with the Business Wire article, disclosing a WebSideStory service that uses "invisible code" placed on the pages to be monitored. The result of including such code is to data mine technical data. Examples of such technical data includes page views, tracking unique visitors, impressions, browsers, plug-ins, screen colors, monitor resolution and "more than 500 other variables that affect how well an e-commerce site can do business."

There is no disclosure within the article that the WebSideStory service tracks commerce transaction activity (e.g. purchases made from the web sites)—instead, only the tracking of visitor traffic to the web site is described. The intent of the WebSideStory product is to allow a commerce site owner to best design the site to handle its visitors:

- By understanding the traffic, a commerce site can purchase more servers to handle additional traffic.
- By understanding the type of browser used by the visiting computers, a commerce site can better program its web pages to appear in those browsers.
- And by understanding the path the user takes through the web site, a commerce site owner can better understand the ease with which the web site graphic user interface allows browsing between related pages.

Again, nothing within the Business Wire article implies that a web site has data fields, that such data fields are filled in, and that the amount with which those data fields are filled in is reported to a second (e.g. third party) server.

The present invention is distinguished from the above operation in the following manner. Under the prior art system, a "tracking service provider" would distribute fixed or "hard coded" Javascript code to the customer who would then paste the code into their web site pages to be tracked. A visitor would download the page from the customer web servers and the code within the page would track visitor visits to that web page by operating on the visitor computer and sending tracking information back to a tracking server provided by the tracking service provider.

The fixed code of the prior art method differs from the ORDER variable provided under a preferred implementation of the new scheme. Under the new process as defined by the present invention, a variable would be provided to the customer within the Javascript code. In the preferred embodiment described in the patent application (see, e.g., page 4, line 30 to page 5, line 19; also Appendix II), the variable is called ORDER and would include such customer defined information as product name, product category, products purchased, and unit price (see, e.g., page 9, lines 40-47). The prior art method of providing fixed code would not be operable to

track purchases made at the visitor computer without a feature like the ORDER variable. Accordingly, providing the ORDER variable is a technical step that provides a technical innovation not available in the prior art.

More specifically, and differentiated from the limitations of claim 1, the prior art method would not be operable to accept commerce information within the data fields of the web page and then operate the data mining code (with commerce variable) on the visitor computer and completed web page to obtain the commercial data.

As the Business Wire article does not introduce features missing from the Papierniak reference, the combined references do not teach all elements of the pending claims and rejection of the claims under §103(a) would fail as a matter of law. Appropriate correction is therefore respectfully requested.

C. *There Is No Suggestion to Combine Features of the Papierniak Reference and the Business Wire Article, Combination of Such References Would Result in Redundant Features, and Such Combination Would Not Result in a Teaching of All Elements of the Pending Claims*

All pending claims have been rejected under §103(a) as being an obvious combination of the cited references, Papierniak and the Business Wire article.

The Federal Circuit has been consistent in reversing the PTO, however, when a rejection is made on the basis of hindsight—that is when an Examiner rejects the application on 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. In In re Rouffett, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolochem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references "is defective as hindsight analysis." The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, "[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of

skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed."

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to "common knowledge and common sense." Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- "The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." (Lee, 277 F.3d at 1343)
- "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." (*quoting* Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000)
- "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (*quoting* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)
- "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." (*quoting* In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).
- "Teachings of references can be combined *only* if there is some suggestion or incentive to do so." (*quoting* In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original)

The sections above remark on the prior art's failure to teach all elements of the claims.

Additionally, the Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined. Each of the patents recite multiple and independent methods for executing

data analyses. No motivation has been presented for picking and choosing elements from various independent embodiments across multiple patents without the inference of hindsight.

Even more important than the failure to fulfill the burden of proof with regard to a combination of references, however, is the fact that the combination cited still would not teach all limitations of the claims. Papierniak references server-side data mining techniques such as those cited within the present application as known in the prior art. The Business Wire article collects only technical data—again, cited within the present application as being known in the prior art. Visitor-side data mining of commercial data, however, is not stated or suggested. Accordingly, rejection of the claims under §103(a) would be inappropriate.

VIII. CLAIMS APPENDIX
37 CFR § 41.37(c)(1)(viii)

A copy of the claims involved in the appeal, Claims 1-9, are attached hereto as an appendix, entitled Claims Appendix.

IX. EVIDENCE APPENDIX
37 CFR § 41.37(c)(1)(ix)

No evidence was submitted pursuant to 37 CFR §§ 1.130, 1.131 or 1.132 of this title, nor was any other evidence entered by the Examiner and relied upon by the Appellant in the appeal.

X. RELATED PROCEEDINGS APPENDIX
37 CFR § 41.37(c)(1)(x)

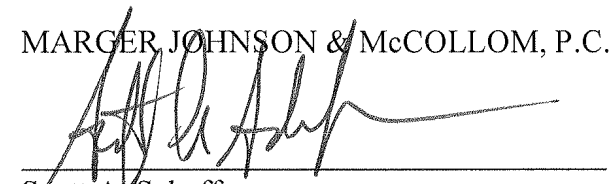
No related proceeding was identified pursuant to 37 CFR § 41.37(c)(1)(ii) of this section.

CONCLUSION

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's rejections to Appellant's claims.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



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VIII. CLAIMS APPENDIX
37 CFR § 41.37(c)(1)(viii)

The text of the claims on appeal, 1-9, are as follows:

1. A method for tracking and reporting electronic commerce activity over a web site comprising:

storing a web page on a first server coupled to a wide area network, said web page including data fields reflecting commerce transaction activity and data mining code;

uploading the web page including the data fields and data mining code to a visitor computer responsive to a request over the wide area network from the visitor computer;

accepting commerce information within the data fields of the web page at the visitor computer to form a completed web page;

operating the data mining code on the visitor computer to obtain technical and commercial data; and

receiving the technical and commercial data at a second server.

2. The method for tracking and reporting electronic commerce activity of claim 1 further including the steps of:

receiving the completed web page at the first server;

generating an order confirmation web page incorporating the commerce information from the data fields of the completed web page, said order confirmation web page including the data mining code; and

uploading the order confirmation web page to the visitor computer.

3. The method for tracking and reporting electronic commerce activity of claim 2, further including the steps of:

associating variables within the data mining code to the commerce information within the order confirmation page;

confirming the commerce information at the visitor computer;

receiving the order confirmation page from the visitor computer at the first server responsive to the step of confirming the commerce information; and

receiving the associated variables at the second server responsive to the step of confirming the commerce information.

4. The method for tracking and reporting electronic commerce activity of claim 3, wherein the step of associating variables includes the steps of associating a variable with a product name of the commercial transaction.

5. The method for tracking and reporting electronic commerce activity of claim 3, wherein the step of associating variables includes the steps of associating a variable with a product category of the commercial transaction.

6. The method for tracking and reporting electronic commerce activity of claim 3, wherein the step of associating variables includes the steps of associating a variable with a number of products purchased in the commercial transaction.

7. The method for tracking and reporting electronic commerce activity of claim 3, wherein the step of associating variables includes the steps of associating a variable with a unit price of the commercial transaction.

8. The method of claim 3, further comprising the steps of:

compiling the variables into a commercial transaction report; and

posting the report for viewing over the wide area network.

9. The method of claim 1 further including the step of embedding the commercial data within a URL request directed at the second server.